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Remarks

Claims 1-15, 20, and 21 are pending in this application. Claim 16-19 have been canceled. Claims 1-15 have been amended. Claims 20 and 21 are new. The Examiner has rejected Claims 1-15 under 35 U.S.C. §§ 101 and 102.

Amendments and New Claims

Claim 1 has been amended to explicitly recite three method steps. The first step of receiving was implied prior to the amendment. The second step of selecting finds support on page 5, line 24 through page 6, line 23 of the specification. The third step was included in Claim 1 prior to the amendment.

Claim 2 now specifies that the manufacturing step of Claim 1 includes manufacturing a set of books. This finds support in Claim 1 prior to its amendment.

The amendments to Claims 3-6 include minor deletions to make those claims consistent with Claim 1.

Claim 7 is a system claim. Prior to amendment it included two elements: an order processing system and a means for manufacturing. Following the amendment, the order processing system is recited as being capable of selecting page and cover media according to a received dimension. This addition finds support on page 5, line 24 through page 6, line 23 of the specification. The means for manufacturing has been replaced with a print module and a finishing module. This finds support on page 3, lines 19-30 of the specification.

The amendments to Claims 8-11 include minor deletions to make those claims consistent with Claim 7.

Claims 12-15 have been amended to recite computer readable media rather than a method. This finds support on page 5, line 12 through page 8, line 20. This section of the specification describes, in part, the role of a computer and, implicitly, media read by the computer. The remaining amendments to Claims 12-15 closely reflect the amendments to Claims 1-6.

New Claims 20 and 21 each depend from Claim 12. Claim 20 includes additional instructions for receiving input identifying a book and expands the selecting instructions of Claim 12 to include instructions for selecting media so

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that when the identified book is produced it will fit in a book storage space. This finds support on page 5, line 24 through page 6, line 23 of the specification.

Claim 21 includes additional instructions for receiving input identifying each book in a set of books and expands the directing instructions of Claim 12 to include instructions for directing the production of the identified set of books so that the set of books will fit in a book storage space. This finds support on page 5, line 24 through page 6, line 23 of the specification.

Rejections Under 35 U.S.C. § 101

The Examiner rejected Claims 1-15 under Section 101 stating that the claimed invention is directed to non-statutory subject matter. More particularly, the Examiner asserted that the claimed invention involves "nominal use of a component, albeit within the technological arts," but that the component "does not affect the underlying process." Claims 1-15 have been amended. Claims 1-6 are directed to a method that can be performed by a computer receiving input and directing one or more printers to produce a tangible output. Claims 6-11 relate to a system that can include that same computer running specific programming and the same printer or printers. Claims 12-15 are directed to computer readable media have specific instructions for achieving a tangible result.

As such, Claims 1-15 are felt to be directed to statutory subject matter.

Rejections Under 35 U.S.C. § 102

The Examiner rejected Claims 1-15 under Section 102 citing U.S. Patent 6,012,890 issued to Celorio Garrido. The Examiner rejected Claims 1-7 and 12 citing a 1983 "Financial Times" article entitled *Technology: Cheap books by chip control*. To properly reject a Claim under section 102, the Examiner must show that each and every limitation set forth in the claim can be found expressly or inherently in a single piece of prior art. *Verdegaal Bros. V. Union Oil Co. of California* 814 F.2d 628, 631 (Fed. Cir. 1987).

Each of Claims 1-15 requires selecting (or a component capable of selecting) page and cover media based upon a dimension of a book storage

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space. Celorio Garrido discusses producing books of various sizes by selecting and perhaps cutting commercially available sheets of paper. C.I. 7, lines 29-46.

The "Financial Times" article discusses a book manufacturing system that enable the purchaser to select the size of the books. However, Celorio Garrido and the "Financial Times" article do not teach selecting page and cover media based upon a dimension of a storage space.

Claims 4-6, 8, 9, and 13-15 each include providing (or a component for providing) a purchase price or receiving or a component for receiving payment information. Neither Celorio Garrido nor the "Financial Times" article teach these limitations.

As such, Claims 1-15 are felt to distinguish over the cited references.

Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully submits that claims 1-15, 20, and 21 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,
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